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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,498	11/01/2001	Len Albert Bayles	10720/4:1	4553
3528	7590	05/19/2005	EXAMINER	
STOEL RIVES LLP - PDX 900 SW FIFTH AVENUE SUITE 2600 PORTLAND, OR 97204			DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/016,498

Applicant(s)

BAYLES ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/15/02, 02/24/03, 09/15/03, 06/04/02, 11/25/02, 10/13/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to Application Number 10/016498 received on 01 November 2001.
2. Claims 1-20 are presented for examination.
3. Applicant's arguments with respect to claim 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 6, and 9 recite the limitation (or a limitation of the same nature) "an acquisition engine to receive from the registry management system a pending delete notification, the pending delete notification preceding the public delete notification, to access the acquisition database, and to request the registry management system to add the new registration for the specific registrar". It is unclear to Examiner how the registry management system can add the new registration for the specific registrar if the deletion of the old registration is pending. Examiner will interpret this limitation to mean acquiring the domain registration after deletion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardos et al. (U.S. Patent Number 6,880,007) in view of Schneider (U.S. Patent Number 6,442,549).

1. Regarding claims 1, 4, 6, 9, 11, and 17, Gardos disclosed a domain name registry system comprising:

a registry management system, having access to a registry database, the registry database containing a current registration record for a domain name, the current registration record having an expiration date (Gardos, Fig 3, 8 and 9).

Gardos also disclosed in Fig. 3, a Register Web Server 150 communicating with a Registrar 153, a database server 152 and a Registry 8. The Register Web Server allows automated domain name registration with the Registry using the database server (see Abstract, col. 6, lines 40-50, 55-67).

However, Gardos does not explicitly state the domain name registry system comprising an acquisition database containing an acquisition request from a specific

registrar to acquire the domain name as soon as practicable following the expiration date and preceding the public delete notification; and

an acquisition engine to receive from the registry management system a pending delete notification, the pending delete notification preceding the public delete notification, to access the acquisition request from the acquisition database, and to request the registry management system to add the new registration for the specific registrar.

In an analogous art of domain name registration, Schneider disclosed a system pertaining towards the availability of domain names where domain names that may soon be available can be reserved from a server (Schneider, col. 26, lines 50-67), and also wherein the completed registration information is submitted by a registrar when the domain name becomes available (Schneider, col. 27, lines 1-15).

The specification defines the phrase "domain acquisition services" to mean "acquiring" (by reserving, holding or substantially immediately registering) a domain name that had been registered, and recently became newly available [see Specification, page 10, paragraph 37]. Based on this definition, Examiner interprets the claimed invention as preordering domains that may soon be available. If a system allows a user to preorder a domain, it is obvious that the Registrar that the user preorders the domain under has first priority for the domain and is therefore notified of the soon to be available domain before any other Registrar. This means that there is some type of acquisition system working with the Registry to enable this priority setting to occur.

Schneider suggests a system for reserving domain name registrations for domain names that are soon to be expired (Schneider, col. 26, lines 50-67). Gardos provides a system of registering domain names where a domain web server, which includes a domain manager, works with the Registry (Fig. 3, 150, 160, 180, 8, 9).

Therefore, it would have been obvious for one in the ordinary skill in the art at the time of the invention to combine the teachings of Schneider with Gardos to provide a domain manager that manage domain registrations with the Registry, providing a way for subscribers to reserve registrations for domain names that are soon to be available without putting the onus of keeping track of current registrations and updating on the subscriber (Schneider, col. 8, lined 40-65).

2. Regarding claims 2 and 3, Gardos and Schneider disclosed the limitations, substantially as claimed, as described in claim 1, including an acquisition front end to receive the acquisition request from the specific registrar and to store the acquisition request in the acquisition database, wherein the acquisition front end is a Web server, and further comprising a Web page hosted by the Web server to receive the acquisition request from the specific registrar (Gardos, Fig. 3, 150).

3. Regarding claim 5, Gardos and Schneider disclosed the limitations, substantially as claimed, as described in claims 1 and 4, including wherein the acquisition of the domain name is a registration of the domain name (Schneider, col. 27, lines 1-3).

4. Claims 7, 8 recite limitations, which are rejected based on the same art used in the rejection of claims 1-6, 9, 11, and 17, and are therefore rejected using the same art as being substantially similar.

5. Regarding claims 10, 12-16 and 18-20, Gardos and Schneider disclosed the limitations, substantially as claimed, as described in claims 9, 11, and 17, including monitoring the status of the current registration of a domain name in order to reserve it once the current registration status has expired in the registry (Schneider, col. 26, lines 50-67).

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

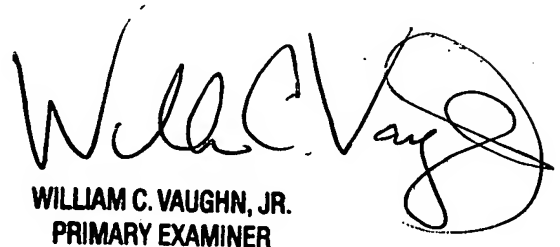
In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. B. D.  
Patent Examiner  
Art Unit 2143

  
WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER